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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,970	09/24/2003	Walter Rosenbaum	2001P05313WOUS	1456
28204	7590	10/20/2006		
SIEMENS SCHWEIZ AG I-47, INTELLECTUAL PROPERTY ALBISRIEDERSTRASSE 245 ZURICH, CH-8047 SWITZERLAND			EXAMINER WEBB, JAMISUE A	
			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/668,970	<b>Applicant(s)</b> ROSENBAUM ET AL.	
	<b>Examiner</b> Jamisue A. Webb	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-41 is/are pending in the application.
- 4a) Of the above claim(s) 31-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Claims 14-30 in the reply filed on 6/12/06 is acknowledged. Therefore Claims 31-41 have been withdrawn from consideration.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 14-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "rejecting said parcel if said franking number and delivery data are not located or said time period has expired" is considered to be new matter. The specification says that a franking number can be invalid after delivery has been made or after a certain period of time. This implies that a validity time period has been assigned to the franking number, however the specification is silent on looking up the franking number, and determining if the validity time period is valid, and delivering the parcel or rejecting the parcel based on if the time period is still valid. Therefore the limitation above lacks support in the original specification.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 14-18, 20, 21, 25, 26, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Fredman (6,526,393).

6. With respect to Claim 14: Fredman discloses the use of a method for franking and processing parcels comprising the steps of:

- a. receiving a parcel franking request (see abstract);
- b. generating a human readable franking number (See Figures 2 and 3 with corresponding detailed description);
- c. storing the franking number and delivery data in a database (Column 4, lines 33-67); and
- d. assigning a validity time period to the franking number (Figure 3 shows a pre-paid shipping label with a tracking number and an expiration date. The shipping label has the expiration date, therefore the examiner considers the tracking number to have an expiration date as well).

7. With respect to Claim 15: Freedman discloses the franking number being read, then looked up in the database, to determine if the number is still valid, and delivering or rejecting the

parcel based on the validity time of the shipping label, therefore the validity time of the tracking/franking number (see abstract).

8. With respect to Claim 16: Freedman discloses the use of receiving payment means (see abstract).

9. With respect to Claim 17: Freedman discloses the use of a delivery address as the destination address (See Figures 1-4).

10. With respect to Claim 18: Freedman discloses the franking number is alphanumeric numbers (See Figure 3).

11. With respect to Claim 20: Freedman uses the shipping label as a return label, therefore the return label is sent to the customer with the franking number on it.

12. With respect to Claim 21: See Figure 3.

13. With respect to Claim 25: Freedman discloses the address is printed out, which is in OCR format, as long as it is an alphanumeric character, it is in OCR format, See Figures 1-4.

14. With respect to Claim 26: Column 4, lines 33-67.

15. With respect to Claim 29: Freedman discloses determining the charge for shipping and charging the sender (see abstract).

16. With respect to Claim 30: Freedman discloses that the cost is based on class of the parcel (See Figure 2, First-Class).

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claims 19 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredman (6,526,393).

20. With respect to Claim 19: Fredman discloses the use of a tracking/franking number, however fails to disclose the initial franking number is a symbol. However, the way the tracking number is arranged, whether they be alpha numeric characters, or symbols is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The tracking steps would be performed the same regardless of what type of character comes first in the franking number. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

21. With respect to Claims 22-24: Fredman also fails to disclose the limitations of validating the delivery address, checking to see if the address is in a forward address database, updating the

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address and informing the sending of the forwarded address. Official notice is taken that it is old and well known with the mailing/shipping art, that when anything goes through the mail system the address is checked with a forwarding address database, and the address is forwarded (when you get mail that has been forwarded to you, there is a yellow address label placed on the envelope that states the letter has been forwarded), and on the envelope there is a statement of "address correction requested" which means the sending is notified of the forwarded address. Therefore, one of ordinary skill in the art would have been motivated to check the address for a forwarding address, to ensure the letter/mailling/parcel, gets to the correct person at the correct address.

22. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredman in view of Bilibn et al. (US 2005/0197892).

23. With respect to Claims 27 and 28: Freedman, as disclosed above, discloses the use of a tracking number, but does not specifically disclose tracking the parcel through the mail system using the tracking (franking) number. Bilibin discloses the use of a carrier system, which assigns carrier tracking numbers and uses the tracking numbers for tracking the parcel through the delivery process (Paragraphs 0449-0451). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Freedman, to include the tracking process of Bilibin, in order to provide a user with up to date information, on where the package is (See Bilibin, Paragraphs 0427-0454).

***Response to Arguments***

24. Applicant's arguments with respect to claims 14-30 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

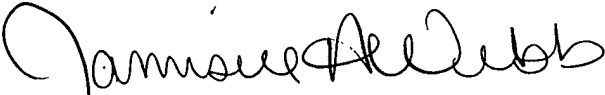
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

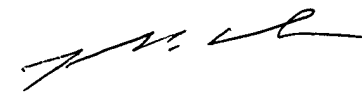


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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